REMARKS

Applicants acknowledge receipt of the Final Office Action dated June 19, 2007. In that action, the Examiner (1) rejected claims 1-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,525,975, issued to McWethy (hereinafter "*McWethy*"); (2) rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *McWethy*; and (3) objected to claims 18-20 as being dependent upon a rejected base claim but determined these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully request the Examiner to reconsider his rejections and objections in view of the Request for Continued Examination, preceding amendments and following remarks.

I. STATUS OF THE CLAIMS

Claims 1-5, 8 and 10-23 are currently pending.
Claims 6, 7 and 9 are canceled.
Claims 1-5, 8 and 10-16 are currently amended.
Claims 21-23 are new.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *McWethy*. To anticipate these claims, *McWethy* must teach every aspect of the claimed invention either explicitly or impliedly. For the reasons stated below, *McWethy* lacks one or more features of each claim.

Claim 1

1. Claim 1 is directed to a multistory building for resisting catastrophic shear forces. The claimed shear forces are discussed throughout the present specification and file history. For example, high winds and seismic activity cause catastrophic shear forces. For reference purposes, it is generally understood that "catastrophic" means "relating to a sudden, violent disturbance." Dictionary.com. *Dictionary.com Unabridged (v 1.1).* Random House, Inc. http://dictionary.reference.com/browse/catastrophic. *McWethy* discloses a different kind of building, one focused on easing the burden of transporting pre-formed modules and reducing

vertical loads. *McWethy*, columns 1 and 2. Because *McWethy* is focused on entirely different objectives, it will become clear herein that *McWethy* simply does not teach every aspect of the claimed invention.

2. The claimed rigid member is adapted to couple the tops of the building portions and to resist the catastrophic shear forces in the shear walls. It is material to the patentability of claim 1 that the building resist the catastrophic shear forces in the shear walls. The claimed rigid member is adapted to do this. Where a condition is material to patentability, it cannot be ignored in order to change the substance of the invention. *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005). Therefore, the claimed rigid member adapted to resist the catastrophic shear forces in the shear walls cannot be ignored. *McWethy* discloses a member resting atop the top row of modules 14 and sidewalls 18, but nowhere shows or describes a rigid member adapted to couple stacked shear walls and to resist catastrophic shear forces therein.

3. The claimed building includes "shear walls." This term has special meaning in the industry, and does not suggest just any wall. A shear wall is designed specifically to counter lateral loads. One having ordinary skill in the art recognizes this. As evidence, Applicants refer to the references submitted in the IDS and PTO Form 1449 dated 8 December 2003 (specifically, Zhang et al., "Seismic Behavior of Reinforced Concrete Shear Walls Subjected to High Axial Loading," ACI Structural Journal, 2000 [attached as Exhibit A]; Taylor et al., "Design of Slender Reinforced Concrete Walls with Openings," ACI Structural Journal, 1998 [attached as Exhibit B]; and Wallace, John W., "Reinforced Concrete Walls: Recent Research & ACI 318-2001," 6th U.S. National Conference on Earthquake Engineering [attached as Exhibit C]). *McWethy* does not disclose "shear walls" as understood in the industry and by one having ordinary skill in the art. In fact, *McWethy* is solely focused on vertical loads, as opposed to lateral loads associated with wind, seismic activity and catastrophic shear forces of the kind shear walls are designed to resist.

4. *McWethy* does not disclose a rigid member adapted to couple and to resist catastrophic shear forces. *McWethy* does not disclose the use of shear walls. Simply put, *McWethy* teaches a building for easy transportation of pre-formed modules capable of carrying vertical loads, and not a building for resisting catastrophic shear forces caused by lateral loads, as claimed. For at least these reasons, *McWethy* cannot anticipate claim 1.

Claim 2

1. For the following additional reason, claim 2 is not anticipated by *McWethy*. The coupling member of *McWethy*'s Figure 1 to which the Examiner refers appears as a single member. Claim 2 includes a plurality of rigid members. One member is not multiple members, thus *McWethy* does not anticipate claim 2 under the standard of § 102(b).

Claims 5 and 10

1. For the following additional reason, claim 5 is not anticipated by *McWethy*. Claim 5 includes a rigid member that is further adapted to induce first plastic hinges adjacent the bottom ends and second plastic hinges adjacent the top ends in response to the catastrophic shear forces. As stated by the Federal Circuit in *Hoffer*, where a condition is material to patentability, it cannot be ignored in order to change the substance of the invention. The claimed rigid member is adapted to induce plastic hinges in response to the catastrophic shear forces. Such a member, material to patentability, and which cannot be ignored, is not shown or described in *McWethy*. *McWethy* cannot anticipate claim 5.
2. Similarly, *McWethy* does not show or describe a rigid member adapted to induce a flexural moment in the building in response to the catastrophic shear forces, as in claim 10.

Claim 11

1. Claim 11 is directed to a multistory building for resisting catastrophic shear forces. Claim 11, like claim 1, includes a rigid member adapted to connect the stacks and to resist catastrophic shear forces in the stacks. For the above-noted reasons, *McWethy* does not disclose the claimed rigid member and cannot anticipate claim 11 for this reason.
2. Furthermore, the claimed building includes "poured-in-place concrete tunnels." Like shear walls, this term has special meaning in the industry, and does not suggest just any sidewall or floor. Poured-in-place concrete tunnels, also known as tunnelform, include walls and slab that are poured simultaneously, and "in-place," in "tunnels" at great reduction of cost and time. One having ordinary skill in the art recognizes this. As evidence, Applicants refer to the reference submitted in the IDS and PTO Form 1449 dated 8 December 2003 (specifically, "Tunnelform," EDI Architecture Inc., 2000 [attached as Exhibit D]). *McWethy* does not disclose "poured-in-place concrete tunnels"

as understood in the industry and by one having ordinary skill in the art. First, the *McWethy* modules are pre-formed either at a factory or at the construction site (col. 2, ll. 28-34) for application to the building, and thus not "poured-in-place." The significance of tunnelform is the creation of shear walls to resist lateral loads, and it has already been established that *McWethy* does not disclose shear walls.

3. *McWethy* does not disclose a rigid member adapted to connect and to resist catastrophic shear forces in the stacks of tunnelform. McWethy does not disclose the use of poured-in-place concrete tunnels. *McWethy* teaches a building for easy transportation of pre-formed, not poured-in-place, modules capable of carrying vertical loads, and not a building for resisting catastrophic shear forces caused by lateral loads, as claimed. For at least these reasons, *McWethy* cannot anticipate claim 11.

Claim 12

1. For the following additional reason, claim 12 is not anticipated by *McWethy*. Claim 12 includes an axis of the first stack of tunnels that is perpendicular to an axis of the second stack of tunnels. *McWethy* shows all modules having parallel axes. *McWethy* does not describe the claimed perpendicular arrangement. Thus *McWethy* does not anticipate claim 12 under the standard of § 102(b).

Claim 13

1. Claim 13 is directed to a multistory building for resisting seismic actions. Claim 13 includes means for connecting stacks of shear walls and maintaining the connection during movement in response to the seismic actions. *McWethy* does not disclose the claimed means.

2. To disclose the claimed means for connecting stacks of shear walls and maintaining the connection during movement in response to the seismic actions, *McWethy* must teach structure that performs the claimed functions. Namely, *McWethy* must disclose a structure that connects shears walls and maintains the connection during movement from seismic actions. *McWethy* does not disclose structures performing the claimed functions, and thus does not anticipate claim 13.

3. As previously stated, *McWethy* also does not disclose shear walls. For at least these reasons, *McWethy* does not anticipate claim 13.

Claims 14 and 15

1. For the following additional reasons, claims 14 and 15 are not anticipated by *McWethy*. McWethy does not teach structure performing the claimed inducing functions as in claims 14 and 15.

Claim 16

1. For the various reasons stated herein, *McWethy* does not teach each and every aspect of claim 16. Specifically, *McWethy* does not teach resisting the catastrophic shear forces with the rigid member and maintaining the connection between the first and second series during movement in response to the catastrophic shear forces. *McWethy* also does not disclose shear walls. Therefore, *McWethy* does not anticipate claim 16 for at least these reasons.

New Claims 21, 22 and 23

1. For the various reasons stated herein, *McWethy* does not teach each and every aspect of these claims. Specifically, *McWethy* does not teach a rigid member adapted to maintain the coupling between the first and second ends in the unloaded position and in the loaded position that is responsive to the catastrophic shear forces (claim 21); wherein the first top row, the second top row and the rigid member are moveable in response to the catastrophic shear forces, and the rigid member is adapted to maintain the connection during the movement (claim 22); and wherein the means for connecting and maintaining includes a stiff, rigid member firmly coupled to the first and second stacks such that the first and second stacks move together substantially simultaneously and coincidentally between the unloaded and loaded positions (claim 23). For at least these additional reasons, claims 21, 22 and 23 are not anticipated by McWethy.

For all of these reasons, the features of the pending claims are not taught or suggested by the prior art. Applicants respectfully request withdrawal of the rejections and allowance of the claims.

CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. No new matter is introduced by way of amendment. It is believed that each ground of rejection raised in the Final Office Action dated June 19, 2007 has been fully addressed. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Conley Rose, P.C.'s Deposit Account Number 03-2769 (2187-00101).

Respectfully submitted,

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